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In re Application of:
FLAHAUT, Dominique, Marianne, Lucienne : DECISION ON PETITION UNDER
U.S. Application No.: 10/533,034 : 37 CFR 1.47(b)
PCT No.: PCT/GB2003/004665 :
International Filing Date: 30 October 2003 :
Priority Date: 04 November 2002 :
Attorney Docket No.: 040587/291713 :
For: HIGH TEMPERATURE RESISTANT :
ALLOYS :

This decision is issued in response to the "Petition Under 37 CFR 1.47(b)" filed 13 April 2006. Applicant has submitted the required petition fee.

BACKGROUND

On 30 October 2003, applicant filed international application PCT/GB2003/004665. The international application claimed a priority date of 04 November 2002 and designated the United States. On 21 May 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 04 May 2005.

On 28 April 2005, petitioner filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 13 September 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration under 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 13 April 2005, petitioner filed the surcharge payment and the petition considered herein (with required five-month extension fee). The petition seeks acceptance of the application without the signature of the sole inventor, whom petitioner states has refused to execute the application papers.

DISCUSSION

A grantable petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be

reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages.

Regarding item (1), petitioner has submitted the required petition fee.

Regarding item (2), where it is asserted that the inventor has refused to execute the application papers, section 409.03(d) of the MPEP requires that the nonsigning inventor first be provided with a copy of the complete application papers, including specification, drawings and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Here, petitioner has provided a firsthand statement, with documentary support, demonstrating that the applicant has been provided with a copy of the complete application papers, along with a declaration and a request for signature, and that the applicant has not provided the signed declaration. These materials satisfy item (2).

Regarding item (3), the petition includes an express statement of the last known address of the nonsigning inventor and of her attorney. Item (3) therefore is satisfied.

Regarding item (4), the petition includes a declaration executed on behalf of the nonsigning inventor by Ian Dunkinson as an authorized representative of the 37 CFR 1.47(b) applicant, Doncasters Limited. Item (4) is therefore satisfied.

Regarding item (5), section 409.03(f) of the MPEP states the following:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Petitioner here asserts a proprietary interest based on an agreement to assign (the "Undertaking") and applicable law. The MPEP states the following with respect to an agreement in writing to assign an invention:

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an

agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

Here, petitioner has provided a statement from Mr. Ian Dunkinson, who states that he has the required first hand knowledge of the facts contained therein. Mr. Dunkinson states that the invention underlying the present application was made during the inventor's employment "with Doncasters plc, which subsequently became Doncaster Limited." Petitioner has also included a copy of the "Undertaking" in which the inventor agreed that all inventions made during the period of her employment would belong to Doncasters plc. Petitioner has therefore provided a proper showing that Doncasters plc has the required proprietary interest in the application. However, petitioner has not provided any documentary support regarding the purported conversion of Doncaster plc to Doncasters Limited, the 37 CFR 1.47(b) applicant. Before the demonstrated proprietary interest of Doncasters plc can be imputed to Doncasters Limited, petitioner must provide an adequate showing confirming that Doncasters plc is now Doncasters Limited. Until such materials are provided, it cannot be concluded that the 37 CFR 1.47(b) applicant (Doncasters Limited) has the required proprietary interest in this application. Item (5) is therefore not satisfied on the present record.

Regarding item (6), the petition includes the required statement that granting of the present petition is necessary to preserve the rights of the parties or to prevent irreparable damages. Item (6) is therefore satisfied.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)" and must include the materials required to satisfy item (5) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459